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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,488	11/05/2001	Siegfried K. Holz	2497.0020000/MBR/MWR	5623

26111 7590 11/28/2007  
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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GLASS, RUSSELL S

ART UNIT	PAPER NUMBER
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3626

MAIL DATE	DELIVERY MODE
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11/28/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/008,488		HOLZ, SIEGFRIED K.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Russell S. Glass		3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/25/2007 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao, (U.S. 6,283,761), in view of McCormick, (U.S. 2002/0035484).**

2. As per claims 2 and 5, Joao discloses a method of preparing and fulfilling a medication prescription written by a physician for a patient at the time of physical examination comprising the steps of:

- B. reading said stored memory into a first PMC reader/writer from said PMC and viewably presenting said stored memory on a personal digital assistant (PDA), (Joao, col. 14, lines 49-58; col. 40, lines 3-12);
- C. modifying said stored memory of said PMC by a physician via entry on said PDA to include a new medication prescription to form an updated stored memory, (Joao, col. 19, lines 12-20, 31-40);
- D. reading said updated stored memory of said PMC via a second PMC reader into an office computer of the physician, said office computer programmed to electronically transfer said updated stored memory to a central host server, (Joao, fig. 2, col. 15, line 59-col. 16, line 18; col. 19, lines 12-20, 31-40; col. 40, lines 3-12)(reference discloses that all system components can have card reader/writers);
- E. transferring said updated stored memory to the host server, (Joao, col. 15, lines 18-46);
- G. receiving a prescription conformation from the pharmacy, (Joao, col. 31, line 66-col. 32, line 45)(notification is considered to be conformation).
- H. electronically transmitting information regarding the examination and the new medication prescription to an insurer of the patient, (Joao, col. 36, line 66-col. 37, line 21).

Joao fails to disclose the following method steps, however, such steps are obvious as evidenced by reference to McCormick:

- A. providing a patient with a personal memory card (PMC) having a stored memory, wherein said stored memory includes at least the patient's personal information,

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consulting physician information, and a plurality of preferred pharmacy information, (McCormick, ¶ 54, 95).

F. transmitting a prescription fulfillment request electronically by said host server for the new medication prescription contained within said updated stored memory to a first preferred pharmacy, wherein said first preferred pharmacy is selected from the plurality of preferred pharmacy information in the host memory, said host server configured for electronically transmitting said request, (McCormick, ¶ 54, 95).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Joao and McCormick. The motivation would have been to have a patient conveniently fill prescriptions at a their regular local pharmacy, (McCormick, ¶ 54).

3. As per claim 9, McCormick discloses a method comprising:

A. storing data on a personal memory card (PMC), wherein said data includes a patient's personal information, a consulting physician's information, and a list of preferred pharmacies(McCormick, ¶ 54, 95).;

B. inserting said PMC into a first PMC reader/writer(McCormick, ¶ 54, 95).;

C. modifying said stored data to further include a medical prescription(McCormick, ¶ 54, 95).

D. withdrawing said PMC from the first PMC reader/writer(McCormick, ¶ 54, 95).;

E. inserting said PMC card into a second PMC reader/writer, wherein said second PMC reader/writer is coupled to a computer system, said computer system

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having a transmitter to deliver a prescription request to a pharmacy, (McCormick, ¶ 71-73)(disclosing a receptionist reader, a physician PDA reader, and electronic prescription transmission);

F. transmitting a prescription fulfillment request to a first pharmacy, wherein the first pharmacy is selected from the list of preferred pharmacies stored on the PMC, (McCormick, ¶ 54, 95);

H. withdrawing the PMC from the second PMC reader/writer, (McCormick, ¶ 71-73).

McCormick fails to expressly disclose the following steps, however, the steps are obvious in view of the cited portions of Joao:

G. receiving a prescription fulfillment confirmation or denial from the first pharmacy, (Joao, col. 31, line 66-col. 32, line 45)(notification is considered to be conformation).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Joao and McCormick. The motivation would have been to have a patient conveniently fill prescriptions at their regular local pharmacy, (McCormick, ¶ 54).

4. As per claims 3, 4, 6, 7 and 8 these system claims contain essentially the same or similar limitations as corresponding method claims 2, 5 and 9, and are therefore rejected on the same basis as claims 2, 5 and 9. The citations applied against method claims 2, 5 and 9 are hereby incorporated against claims 3, 4, 6, 7 and 8 by reference.

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**5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao, (U.S. 6,283,761), in view of McCormick, (U.S. 2002/0035484), and further in view of Rosenblum, (U.S. 2003/0093181).**

6. The method of claim 9, wherein if in step G a prescription fulfillment denial is received, then the method further comprises:

- I. transmitting a prescription fulfillment request to a second pharmacy, wherein the second pharmacy is selected from the list of preferred pharmacies stored on the PMC, (Rosenblum, ¶ 93) (disclosing a system and method wherein a remote prescription pharmaceutical dispenser in geographic proximity to a patient receives a prescription and if it is determined that the remote dispenser has drugs, then the patient is directed there, and if no drugs are present to fill the prescription, then the patient is directed toward another location in geographic proximity, and wherein the remote prescription pharmaceutical dispenser is equivalent to a pharmacy); and
- J. receiving a prescription fulfillment confirmation or denial from the second pharmacy, (Rosenblum, ¶ 93)(determining whether a second remote prescription pharmaceutical dispenser has sufficient stock to dispense a prescription).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Joao and McCormick. The motivation would have been to have a patient conveniently fill prescriptions at a their regular local pharmacy, (McCormick, ¶ 54).

It would have been obvious to add Rosenblum to the combination of Joao and McCormick. The motivation would have been to provide convenient alternative pharmacies to a patient, (Rosenblum, ¶ 93).

### ***Response to Arguments***

Applicant's arguments filed 10/25/2007 have been fully considered but they are not persuasive for the following reasons:

1. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the patient *carries the PMC with him*; and that a plurality of preferred pharmacies is *a list of pharmacies closest to a person's home, a list of pharmacies accepting the patient's insurance, or any general list of patient-specified pharmacies, and an active feedback loop that allows a patient to leave the office knowing exactly which pharmacy will fill the prescription*) (emphasis added) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
2. As per applicant's argument that the combination of Joao and McCormick fails to disclose a PMC containing information on a plurality of preferred pharmacies, it is submitted that under the broadest reasonable interpretation of the claims, McCormick would disclose this limitation to one of ordinary skill in the art. McCormick discloses a doctor's terminal with multiple pharmacies and allowing a patient to select a convenient



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pharmacy from the map, (McCormick, ¶ 54). This is considered to be equivalent to information on a plurality of preferred pharmacies. Furthermore, McCormick discloses a physician storing pharmacy and prescription information on a patient smart card, (McCormick, ¶ 95).

3. In response to applicant's arguments against the Joao reference individually, it is submitted that the McCormack reference was cited against the features argued by applicant. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

4. As per applicant's argument that the combination of Joao, McCormick, and Rosenblum fails to disclose what is essentially system that continues to process the prescription request until a preferred pharmacy is located, it is submitted that Rosenblum discloses such prescription processing, (Rosenblum, ¶ 93).

### ***Conclusion***

This is a continuing examination of applicant's earlier Application No. 10/008,488. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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